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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,394	11/18/2003	James R. Lisk JR.	2C03.1-071	4405

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EXAMINER

BUTLER, PATRICK

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

Office Action Summary	Application No.		Applicant(s)	
	10/716,394		LISK ET AL.	
	Examiner		Art Unit	
	Patrick Butler		1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13, 19-24 and 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The restriction in the Office Action of 05 October 2005 is withdrawn and replaced as follows. Applicant's arguments are moot in view of the new grounds of Restriction.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 14-18, and 25-28, drawn to a method of processing, classified in class 264, subclass 1.32.
- II. Claims 13, 19, 22-24, and 29, drawn to drawn to an ocular item, classified in class 623, subclass 6.56.
- III. Claim 20, drawn to an apparatus, classified in class 425.
- IV. Claim 21, drawn to a composition, classified in class 252.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method could be used to make another product such as a polished stone.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as polishing stone.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions IV and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product (composition) as claimed can be used in a materially different process using that product such as polishing stone.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the

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apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus can be used for making a materially different product such as a making a polished stone.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions II and IV are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, they are mutually exclusive because the composition polishes, but the product is polished; they are not obvious variants because composition polishes, but the product is polished; and they have a different operation because the product is operated on in polishing, whereas the composition does the operating in its use.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and

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(2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a solution, nor, more specifically, polishing elements dispersed in the aqueous solution. The subcombination has separate utility such as an apparatus that pours the solution over the item to be polished rather than having a tumble polisher.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Further restriction to one of the following species is required under 35

U.S.C. 121:

This application contains claims directed to the following patentably distinct species:

- A. solutions with multivalent cations and inducing formation of materials (Claims 26-28) and
- B. solutions without multivalent cations and **preventing** formation of materials (Claims 1-12, 14-18, and 25).

The species are independent or distinct because the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the species as claimed are not obvious variants; and the species as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, they are mutually exclusive (binary opposites), are not obvious variants, and have materially different function (prevent vs. induce).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In Applicant's Arguments, filed 05 January 2006, Applicant affirmed election to the method invention preventing species, claims 1-12 and 14-18.

Given Applicant's prior election to method and preventing, the method and preventing of this restriction are summarily grouped and will be examined: Invention I (method) and Species B (preventing) -- claims 1-12, 14-18, and 25.

Claims 13, 19-24, and 26-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

Response to Amendment

The Applicant's Amendments and Accompanying Remarks, filed 05 January 2006, have been entered and have been carefully considered. No Claims are new, Claim 10 and 18 are amended, no Claims are canceled, and Claims 1-12, 14-18, and 25 are pending.

The Text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.

Information Disclosure Statement

In the Office Action dated 05 October 2005, it was noted that the JP document on the IDS filed 17 May 2004 fails to provide an English language translation.

Applicant argues that a translation is not required, and an English language abstract was submitted.

However, it is noted that the JP original document to be considered is not in English, which Applicant acknowledges. Therefore, the information disclosure statement filed 17 May 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The submitted abstract filed 05 January 2006 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information

disclosure statement. The abstract has been placed in the application file, but the information referred to therein has not been considered. Specifically, for an abstract to be considered, an IDS listing said abstract is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 18, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reduced" in claim 1 and 25 is a relative term, which renders the claims indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The protein affinity parameter has been rendered indefinite because of the relative terminology. Claims 2-12 are rejected via their dependency.

For purposes of examination, the examiner interprets the term as applied to protein affinity to represent having a low protein affinity.

Claim 10 recites the limitation "unchanged temperature" in Claims 10 and 18. There is insufficient antecedent basis for this limitation in the claim. Setting a higher temperature of the flushing step is a method of changing the method of flushing. Within the step, as recited in the claim, there is no change. Therefore, there is no antecedent

temperature to compare this temperature to. For purposes of examination, the examiner assumes a temperature above room temperature (22-23 degree Celsius).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Šulc et al. (US Patent No. 4,893,913).

With respect to Claim 1, Šulc teaches treating a lens with a hydrophilic surface layer in a solution and washing the lens (processing an item at least partially formed of a hydrophilic polymeric material) so that the surface becomes protected from depositions of proteins (to produce a reduced protein affinity) (see col. 1, lines 52-63; col. 2, lines 8-16; and col. 3, lines 4-8). In the process taught by Šulc, embodiments of the first solution use salts such as sodium phosphate (see col. 2, lines 45-65). Because sodium phosphate is used as the alternative to calcium or magnesium chloride, formation of insoluble ionic materials is prevented principally because the components necessary to form insoluble ionic materials are not present (see Applicant's Specification, paragraph [00006]) (preventing the formation of insoluble ionic materials in or on the items during processing).

With respect to Claim 2, Šulc teaches swelling the outer surface (hydrating the item) (see col. 2, lines 13-16 and lines 56-65). The solution is free of multivalent cations

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as sodium phosphate may be used as the salt rather than the salts containing multivalent cations: calcium or magnesium chloride (see col. 2, lines 45-55). The treating occurs with sodium phosphate, which is a buffer (see col. 2, lines 56-65 and Applicant's Specification, paragraph [00022]) (processing the item in the presence of a buffer). The lens is rinsed with water (see col. 2, lines 8-13 and col. 3, lines 35 and 36) (flushing the buffer from the item using a solution free of multivalent cations).

With respect to Claim 9, Šulc teaches that a mixture of two or more salts can be employed, which would allow for sodium acetate and sodium phosphate to be employed (a buffer system of mixed anions) (see col. 2, lines 45-55).

With respect to Claim 10, the processing, that is treating and washing, is carried out above 50 degrees Celsius (see col. 3, lines 4-8) (the step of flushing the buffer from the item in a solution free of multivalent cations is carried out at a temperature greater than room temperature of about 21-23 degrees Celsius).

With respect to Claim 11, the processing includes additional swelling by immersion into physiologic saline (see col. 2, lines 23-27) (equilibrating the item in a saline solution).

With respect to claim 12, the treating solution teaches using sodium phosphate rather than calcium or magnesium chloride (the step of preventing the formation of insoluble ionic materials in or on the item during processing comprises the exclusion of multivalent cations from a processing solution).

Claim Rejections - 35 USC § 103

Claims 3-6, 8, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Šulc et al. (US Patent No. 4,893,913) as applied to claim 2 above, and further in view of Robinson (US Patent No. 6,095,901).

With respect to Claims 14, 3, and 5, Šulc teaches processing a lens (ocular item) as previously described.

Šulc does not explicitly teach utilizing glass-polishing beads to process a lens.

Robinson teaches polishing lens in slurry containing polishing beads, alumina, and a swelling agent (see col. 1, lines 40-44 and col. 4, lines 5-13). The polishing is done by tumble-polishing (see col. 5, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Robinson's polishing beads with Šulc's treating step in order to remove rough spots, sharp edges, and any tool or machining marks from the article's surfaces (see col. 4, lines 59-63). Moreover, Robinson specifically states that any agent capable of swelling the article to be polished without irreversibly damaging it will be suitable.

Šulc's treating step includes using sodium phosphate (see col. 2, lines 45-55) (a phosphorus buffer) as previously described.

With respect to Claims 4 and 15, Robinson teaches that the beads are preferable glass beads (see col. 3, lines 24-29) (glass polishing beads).

With respect to Claim 6 and 16, Šulc teaches that the treating solution is alkaline ([Claim 6] the item is processed in an alkaline aqueous solution; [Claim 16] maintaining the polishing slurry solution at a pH of at least 7) (see col. 2, lines 56 and 57).

With respect to Claim 8, Šulc teaches processing using sodium acetate (an acetate buffer) (see col. 2, lines 45-55).

With respect to Claim 17, Šulc teaches that the processing includes additional swelling by immersion into physiologic saline (equilibrating the item in a balanced saline solution) (see col. 2, lines 23-27).

With respect to Claim 18, Šulc teaches that the processing, that is treating and washing, is carried out above 50 degrees Celsius (see col. 3, lines 4-8) (the flushing step is carried out at a temperature greater than room temperature of about 21-23 degrees Celsius).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Šulc et al. (US Patent No. 4,893,913) in view of Robinson (US Patent No. 6,095,901) as applied to Claim 3 above, and further in view of Rankin (US Patent No. 3,767,788).

With respect to Claim 7, Šulc in view of Robinson teaches processing a lens as previously described. Šulc's treating step includes using sodium phosphate (see col. 2, lines 45-55) (a phosphorus buffer) as previously described.

Šulc and Robinson are silent as to the use of a borate buffer.

Rankin teaches that in ophthalmic solution useful for lens, it is useful to use sodium borate and sodium phosphate interchangeably to maintain basic pH (wherein the polishing slurry comprises a borate buffer) (see col. 1, lines 55-69 and col. 5, line 69 through col. 6, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Rankin's sodium borate in place of Šulc and Robinson's

sodium phosphate because they are interchangeable to achieve the same end result of maintaining an alkaline pH. Moreover, due to the environmental degradation issues of algae bloom caused by phosphates, it would have been preferable to substitute any known substance in place of a phosphate if it would attain the same functionality in order to eliminate environmental liabilities from phosphate use.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Šulc et al. (US Patent No. 4,893,913) in view of Park et al. (US Patent No. 4,640,941).

With respect to Claim 5, Šulc teaches treating a lens with a hydrophilic surface layer in a solution and washing the lens (processing an item at least partially formed of a hydrophilic polymeric material) so that the surface becomes protected from depositions of proteins (to produce a reduced protein affinity) (see col. 1, lines 52-63; col. 2, lines 8-16; and col. 3, lines 4-8). In the process taught by Šulc, embodiments of the first solution use salts such as sodium phosphate (see col. 2, lines 45-65). Because sodium phosphate is used as the alternative to calcium or magnesium chloride, formation of insoluble ionic materials is prevented principally because the components necessary to form insoluble ionic materials are not present (see Applicant's Specification, paragraph [00006]) (preventing the formation of insoluble ionic materials in or on the items during processing).

Šulc does not explicitly teach utilizing vinyl pyrrolidone as a monomer in the polymer making up the part to be polished.

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Park teaches using vinyl pyrrolidone (organic aromatic structures) with 2-hydroxyethyl methacrylate and siloxane monomer to form lens (see col. 1, line 65 through col. 2, line 4 and col. 2, lines 48-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Šulc's vinyl pyrrolidone and siloxane monomer with the 2-hydroxyethyl methacrylate taught by Šulc in order to form a typical lens composition with excellent oxygen permeability (see col. 2, lines 48-62).

Response to Arguments

Applicant's arguments filed [filing date] have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC 112 rejections. Applicant's arguments appear to be on the grounds that:

1) "Elevated" is not a relative term which renders the claim indefinite because it is supported by the specification.

Applicant argues with respect to the 35 USC 102 rejections. Applicant's arguments appear to be on the grounds that:

2) The examiner has not pointed out to an explicit disclosure in Šulc nor where the limitation can be found inherently within the cited reference for preventing in the formation of insoluble ionic materials in or on the item during processing.

3) It is unclear how sodium is used as the alternative to calcium chloride or magnesium chloride.

4) It appears that the Examiner is asserting that Šulc or the present application teaches that simply treating a lens with a solution of sodium phosphate results in prevention of forming insoluble materials on the item during processing or that Šulc's swelling teach causing this result. Neither does.

5) Šulc clearly teaches treating with a solution of multivalent cation salts.

6) Swelling is not synonymous with hydration, as it is via hydration.

7) The sodium phosphate is not a buffer, as it is only strongly alkaline in aqueous solution.

8) Rinsing is not flushing.

9) If claim 3 is not anticipated, then Claim 8 is not.

10) Processing is not flushing of the buffer from the item.

11) Šulc does not exclude multivalent cations.

Applicant argues with respect to the 35 USC 103 rejections. Applicant's arguments appear to be on the grounds that:

12) The motivation to combine Šulc with Robinson is not present because the lens of Šulc has smooth properties.

13) Šulc has trisodium phosphate, whereas Rankin is replacing mono- and di-sodium phosphate.

14) There is no motivation to substitute constituents from a medicament process to a processing step for producing reduced protein affinity.

15) The salt of Šulc is not a pH buffer; therefore, sodium borate would not be substituted to achieve same end result.

16) Robinson does not disclose sodium phosphate sodium borate (the buffer).

17) Rankin does not disclose polishing slurry with a borate buffer.

The Applicant's arguments are addressed as follows:

1) Applicant's arguments with respect to the 112 rejection have been considered but are moot in view of the new ground(s) of rejection.

2, 3, 4, 5, 11) As stated above in the 102 rejection:

In the process taught by Šulc, embodiments of the first solution use salts such as sodium phosphate (see col. 2, lines 45-65). Because sodium phosphate is used as the alternative to calcium or magnesium chloride, formation of insoluble ionic materials is prevented principally because the components necessary to form insoluble ionic materials are not present (see Applicant's Specification, paragraph [00006]) (preventing the formation of insoluble ionic materials in or on the items during processing).

Applicant's disclosure teaches that having multivalent cations present—calcium or magnesium chloride—induces/allows insoluble ionic material. Šulc provides the option of sodium phosphate (see col. 2, lines 48-50). The presence of calcium or magnesium chloride is a different option, as they are “applicable also” (see col. 2, lines 53-55). Exercising the options, one option is to have only sodium phosphate.

Moreover, this option for a single component of the ones shown in the paragraph present is manifested in the statement that “two or more can be

employed" (see col. 2, lines 52 and 53). This reinforces the option of only having one, with the one being from the examples given, with an example given being sodium phosphate.

Given that the option of Šulc to not have the multivalent cations present, the prevention of formation of insoluble material occurs as stated in Applicant's specification [paragraph 00006].

6) As stated by Applicant's remarks, the hydrating is done via water. This is relied upon to show addition of water, which would cause swelling due to the increased volume.

7 and 15) The sodium phosphate controls the pH, thus it acts to buffer the solution. The presence of sodium borate would also act to control the pH.

8) Rinsing the material is equated with flushing because of the use of water to remove the excess material present.

9) Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

10) As Šulc is teaching having the object in water, this would effectively flush the buffer from the item.

12) Smoothness of the sides and sharp edges address different concerns. A sharp edge would injure an eye regardless of how smooth the side is leading to the point. Therefore, it would be a motivation to have no sharp edges on an already smooth object.

13) Rankin and Šulc would both be recognized to teach sodium phosphates, which could be used to maintain desired pH.

14) Both inventions are directed to ocular use.

16) Robinson is not relied to disclose sodium phosphate and borate. Šulc and Rankin are.

17) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, Rankin is only relied upon to teach using borate buffer, not to teach the polishing as well.


Conclusion

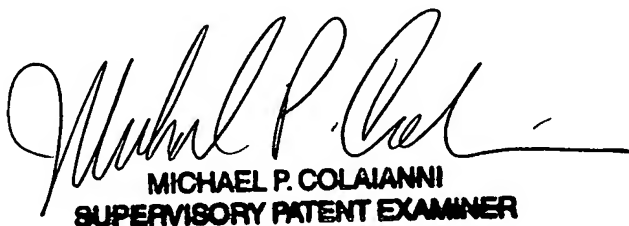
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is 571-272-8517. The examiner can normally be reached on Monday through Friday 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick Butler
Assistant Examiner
Art Unit 1732


MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER